

REMARKS

The Specification has been amended to correct typographical errors. Claims 1 and 4 have been amended. Claims 20 - 21 have been added. No new matter has been introduced with these amendments or added claims, all of which are supported in the application as originally filed. Claim 6 has been cancelled from the application without prejudice. Claims 1, 3 - 4, and 13 - 21 are now in the application.

Applicants are not conceding that the subject matter encompassed by the claims as presented prior to this Amendment is not patentable over the art cited by the Examiner, and claim amendments and cancellations in the present application are directed toward facilitating expeditious prosecution of the application and allowance of the currently-presented claims at an early date. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by the claims as presented prior to this Amendment and additional claims, in one or more continuing applications.

I. Rejection under 35 U. S. C. §102(e)

Paragraph 5 of the Office Action dated March 6, 2009 (hereinafter, “the Office Action”) states that Claims 1, 3 - 4, 13, and 15 - 19 are rejected under 35 U.S.C. §102(e) as being anticipated by U. S. Patent Publication 2004/0043758 to Sorvari et al. (hereinafter, “Sorvari”). This rejection is respectfully traversed with regard to the claims as currently presented.

MPEP §706.02, paragraph V, states with regard to an anticipation rejection under 35

U.S.C. §102, “... the reference must teach every aspect of the claimed invention either explicitly or impliedly” (emphasis added). As part of the analysis under 35 U.S.C. §102, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.¹

The initial burden of making out a *prima facie* case of anticipation is on the Patent Office.² When the Patent Office has made out a *prima facie* case of anticipation, the burden then shifts to the Applicant to rebut it.³

Applicants respectfully submit that this burden has not been met, as the Examiner has failed to clearly identify the corresponding elements disclosed in the allegedly anticipating reference, in violation of the holding in **Lindermann Maschinenfabrik GMBH**. The burden of rebuttal has therefore not passed to Applicants.

Furthermore, Applicants respectfully submit that the rejection in the Office Action does not comply with 37 C.F.R. §1.104(c), “Rejection of Claims”, which states in paragraph (2),

In rejecting claims for want of novelty ..., the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part

¹*Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, *supra*.

²*In re Bass*, 177 USPQ 178, 186 (C.C.P.A. 1973).

³*Id.*

relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained. (emphasis added)

In violation of 37 C.F.R. §1.104(c), the Office Action simply cites various paragraphs and figures of Sorvari without indicating anything about how those paragraphs and figures are being interpreted. With reference to the claim language recited on lines 4 - 6 of Claim 1, for example, what is it from Sorvari's paragraphs [0061] - [0067] and [0073] - [0078] that is being asserted as teaching Applicants' "mapping"? And what is asserted as teaching "candidate content subscription"? What is asserted as teaching "at least one portion of content"?

Similarly, with regard to the claim language recited on lines 7 - 8, what is it from Sorvari's paragraphs [0166] - [0173] and **Figs. 10 - 11H** that is being asserted as teaching generating a markup language document representing the determined candidate content subscription? Is it the service history log in **Fig. 10**? If so, then Applicants respectfully note that this service history log is not generated to represent a candidate content subscription, and instead was already (i.e., previously) generated (that is, without regard to any "determined candidate content subscription") to represent past recommendations. (See, for example, the heading on the left side of **Fig. 10**.)

In the interest of progressing rapidly to issuance, Applicants have amended independent Claim 1 herein, and respectfully submit that Sorvari clearly fails to teach every aspect of independent Claim 1 as currently presented. In particular, Applicants note that the Office Action admits that Sorvari "does not specifically teach" "... scheduling time on an electronic calendar of the user when any of the at least one portion of the content is considered a match to the trigger".

This claim language was previously recited in dependent Claim 6, and is now recited on lines 16 - 17 of independent Claim 1. The Office Action cited paragraph [0308] of Sorvari and col. 4, lines 10 - 39 of Shaffer when analyzing this claim language under 35 U. S. C. §103 (see paragraphs 24 - 26 of the Office Action). Applicants respectfully disagree with this analysis, as will now be discussed.

The cited paragraph [0308] of Sorvari discusses receiving input (para. [0308], line 2) from a calendar application (para. [0308], line 4). Applicants' claim language does not recite input from a calendar. Sorvari's "Context inference Engine" may use input from a calendar application in determining the device user's current context. See paragraph [0308], lines 11 - 14, referring to using the information for "the decision making of the Context inference Engine", as well as paragraph [0093], lines 1 - 7 (discussing use of the context inference engine to "determine a current context"). As admitted in the Office Action, these discussions of calendars do not teach Applicants' "... scheduling time on an electronic calendar of the user ..." claim language.

The cited col. 4, lines 10 - 39 of Shaffer also fail to teach, or suggest, this claim language. Col. 4, lines 14 - 17 discuss "user-configurable times". However, this refers to a user indicating when a "push service" should send updates pertaining to web sites, and is not related to a person's electronic calendar – and it also does not teach or suggesting scheduling time on such electronic calendar. Col. 4, lines 17 - 20 discuss "scheduled updates". However, these updates are the detected updates of web sites, and in the example, are updated prices of stocks. In other words, at scheduled intervals, the push services sends the current price of selected stocks. This is

also unrelated to a person's electronic calendar, and does not teach or suggesting scheduling time on such electronic calendar.

Col. 4, lines 34 - 39 of Shaffer discuss a "predetermined time interval" after which an event indicator (which indicates updated content) should be deactivated. Again, this is unrelated to a person's electronic calendar, and does not teach or suggesting scheduling time on such electronic calendar.

Paragraph 26 of the Office Action states that it would have been obvious to combine Shaffer with Sorvari "because utilizing a user calendar to have information sent to the user enables the user to dictate when they would receive information and not have information sent every time a match is made from the trigger". In view of this statement, Applicants respectfully submit that their claim language has been misinterpreted. The claim language does not recite "utilizing a user calendar to have information sent to the user", and the claim language does not pertain to limiting transmissions to the user according to any information from the user's calendar. Rather, the claim language recites "... determin[ing] whether at least one portion of the content is considered a match ... and automatically sending each matching portion ... to the user and [also] scheduling time on an electronic calendar of the user when [some] portion ... is considered a match ..." (Claim 1, lines 13 - 17). Shaffer does not recite scheduling time on the user's calendar.

In view of the above, Applicants respectfully submit that independent Claim 1 is patentable over the references as currently presented. Dependent Claims 3 - 4, 13, and 15 - 19 are deemed

patentable at least by virtue of the patentability of Claim 1 from which they depend. The Examiner is therefore respectfully requested to withdraw the §102 rejection of all claims as currently presented.

II. Rejection under 35 U. S. C. §103(a)

Paragraph 23 of the Office Action states that Claims 6 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sorvari in view of U. S. Patent 6,094,681 to Shaffer et al. (hereinafter, “Shaffer”). This rejection is respectfully traversed with regard to the claims as currently presented.

Applicants have demonstrated, above, that the claim recitations from Claim 6 – which are now presented in Claim 1 – are not taught by Sorvari and/or Shaffer. Claim 14 is deemed patentable by virtue of at least the patentability of independent Claim 1 from which it depends. The Examiner is therefore respectfully requested to withdraw the §103 rejection of all claims as currently presented.

III. Added Claims 20 - 21

Added independent Claims 20 - 21 recite claim language analogous to that of independent Claim 1. Claims 20 - 21 are therefore considered patentable over the references according to the same analysis presented above with regard to Claim 1.

IV. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,

/Marcia L. Doubet/

Marcia L. Doubet
Attorney for Applicants
Reg. No. 40,999

Customer Number for Correspondence: 43168
Phone: 407-343-7586
Fax: 407-343-7587